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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,837

09/10/2003

John S. Worley

200206306-1

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11/07/2007

HEWLETT PACKARD COMPANY

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INTELLECTUAL PROPERTY ADMINISTRATION

FORT COLLINS, CO 80527-2400

EXAMINER

NGO, CHUONG D

ART UNIT

PAPER NUMBER

2193

MAIL DATE

DELIVERY MODE

11/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/659,837
Filing Date: September 10, 2003
Appellant(s): WORLEY, JOHN S.

Robert W. Bergstrom
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/13/2007 appealing from the Office action mailed 02/07/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. However, the last amendment filed 04/09/2007 mentioned in the brief is a amendment after final, and has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-19 are clearly directed computer operations and computer implemented method of calculation that merely perform calculations and manipulations of data. In order for such a claimed invention that merely performs calculations and manipulations of data to be statutory, the claimed invention must accomplish a practical application. That is the claimed invention must transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Also see “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”, OG Notices: 22 November 2005. It is clear from claims 1-19 that the claims merely involve calculations and manipulations of data in performing a multiply and add operation on first, second and third operand values and providing results also mere numerical values. The claimed invention does not transform an article or physical object to a different state or thing. The inputs are number and the output are also numbers. The result of the invention is merely

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numerical values without a practical application recited in the claims to make the result useful, concrete and tangible. Therefore, the claimed invention is directed to non-statutory subject matter as the claims fail to accomplish a practical application.

The Claimed operation as recited in claims 1-9 and 19 clearly covers a mere computer software/program without embodied in a computer readable storage medium, and thus is as non-statutory subject matter as being a software/program per se. A computer program or data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F. 3d at 1361,31 USPQ2d at 1760.

(10) Response to Argument

Applicant's arguments in the brief have been fully considered but they are not persuasive.

First, it is respectfully submitted that a computer program or data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F. 3d at 1361,31 USPQ2d at 1760. Therefore, The Claimed operation as recited in claims 1-9 and 19 which are clearly covering a mere computer software/program without embodied in a computer readable storage medium, is a non-statutory subject matter as being a software/program per se.

Further, It is respectfully submitted that the claimed invention is clearly directed to a calculation in a computer, namely a multiply-and-add operation. Such an invention that is directed to a calculation is a 35 U.S.C 101 judicial exception as being an Abstract Idea, and is

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required a practical application of the judicial exception in order to be statutory. See MPEP 2105, IV, C, 2. That is the claimed invention must transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result. Since the claimed invention does not result in a transformation of an article or physical object to a different state or thing, and the result of the invention is a mere numerical value representing a result of multiply and add operation on three operand values, practical applications of the multiply-and-add operation recited in the claim is clearly lacking. Therefore, the claimed invention is directed to non statutory subject matter. Further, the examiner respectfully submits that the elimination of write dependence as disclosed in the specification may be an improvement in performing a multiply-and-add operation, but not an improvement on a computer, and it is not a practical application. The focus of determination whether the claimed invention produce a useful, concrete, and tangible result is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is useful, tangible and concrete. Therefore, it is respectfully submitted that the rejection of claims 1-19 under 35 U.S.C. 101 is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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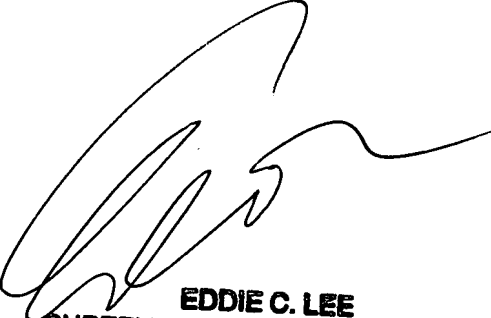
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Chuong D. Ngo/
Primary Examiner, AU 2193.

Conferees:


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